

## **REMARKS**

The Office Action dated July 21, 2008 has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 11, 13, and 30-31 have been amended to more particularly point out and distinctly claim the subject matter of the invention. New claims 35-36 have been added. Claims 7-10 and 24-25 were previously cancelled. No new matter has been added. Therefore, claims 1-6, 11-23, and 26-36 are currently pending in the application and are respectfully submitted for consideration.

### ***Claim Rejections Under 35 U.S.C. §101***

The Office Action rejected claims 33 and 34 under 35 U.S.C. §101 as allegedly directed to non-statutory subject matter. Specifically, the Office Action alleged that a computer program embodied on a computer medium is considered a program *per se*, and is merely a set of instructions capable of being executed by a computer. This rejection is respectfully traversed for at least the following reasons.

Applicants respectfully submit that the Office Action fails to cite any relevant statutory section, federal regulation, controlling case law, or MPEP section to support the Office Action's conclusion that a computer program embodied on a computer medium is considered a program *per se*. In fact, the Office Action's conclusion is directly in conflict

with the relevant portions of MPEP § 2601.01, directed towards computer-related inventions.

Specifically, MPEP § 2601.01 recites that “[w]hen functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.” (MPEP § 2601.01 – Computer-Related Nonstatutory Subject Matter). Claim 33 clearly recites “a computer program embodied on a computer medium for controlling a computer to perform a method.” Thus, claim 33 recites functional descriptive material tangibly embodied on a computer-readable medium, which meets the requirements of MPEP § 2601.01. Thus, claim 33, and claim 34 which is dependent on claim 33, recites statutory subject matter. Accordingly, Applicants respectfully request that this rejection be withdrawn.

### ***Claim Rejections Under 35 U.S.C. §112***

The Office Action rejected claims 33 and 34 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Office Action alleged that the claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. This rejection is respectfully traversed for at least the following reasons.

Applicants respectfully submit that the specification does describe “a computer program embodied on a computer readable medium” in a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention. For example, the specification, at paragraph 0082 discloses that the base band unit 206 includes a digital signal processor, memory and software, and performs digital signal processing. The base band unit 206 may perform tasks of the requesting means, connecting means 106, signaling means 110, and the second signaling means 134. The signaling means 110 and the second signaling means 134 may be implemented with software applications. (See e.g. Specification at paragraph 0082).

Thus, Applicants respectfully submit that one of ordinary skill in the art would readily understand that an embodiment of the invention could be implemented using software applications, and that the software could be tangibly embodied on a computer readable medium. Accordingly, Applicants respectfully request that this rejection be withdrawn.

#### ***Claim Rejections Under 35 U.S.C. §103(a)***

The Office Action rejected claims 1-4, 6, 11, 13-21, 23, 27, and 29-34 under 35 U.S.C. §103(a) as being allegedly unpatentable as obvious over Ratert, *et al.* (U.S. Patent Publication No. 2004/0142684) (“Ratert”) in view of Mittal (U.S. Patent No. 6,842,613) (“Mittal”). The Office Action also rejected claims 22, 26, and 28 under 35 U.S.C. §103(a) as being allegedly unpatentable as obvious over Ratert in view of Mittal and

deTorbal (U.S. Patent Publication No. 2004/0058678) (“deTorbal”). Both of these rejections are respectfully traversed because Mittal is invalid prior art under 35 U.S.C. § 103(c), and neither rejection can stand without Mittal.

35 U.S.C. § 103(c) states that:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. (35 U.S.C. § 103(c)(1)).

Applicants respectfully note that the present application was filed on April 22, 2004, and claims benefit of priority to Finnish Application No. 20040392, filed on March 12, 2004. Applicants further note that Mittal has a patent date of January 11, 2005. Therefore, Mittal qualifies as prior art against the present application, if at all, only under 35 U.S.C. § 102(e). However, both the present application and Mittal were subject to an obligation of assignment to the same entity, namely Nokia Corporation. Evidence of the present application’s assignment to Nokia Corporation may be found in the assignment recorded August 30, 2004 at reel 015744 and frame 0249. Evidence of Mittal’s assignment to Nokia Corporation may be seen on the cover page of Mittal. Thus, Mittal and the present application were both subject to an obligation of assignment to the same entity at the time of the invention, namely to Nokia Corporation. Therefore, according to 35 U.S.C. § 103(c), Mittal is not valid prior art in support of a rejection of the claims in the present application under 35 U.S.C. § 103(a).

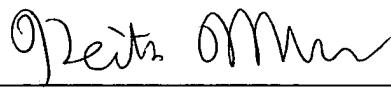
Applicants respectfully assert that the Office Action's rejection of claims 1-4, 6, 11, 13-21, 23, 27, and 29-34 under 35 U.S.C. §103(a), and the Office Action's rejection of claims 22, 26, and 28 under 35 U.S.C. §103(a) cannot stand without Mittal. Thus, Applicants respectfully request that the Office Action's rejection under 35 U.S.C. § 103(a) be withdrawn.

For at least the reasons discussed above, Applicants respectfully submit that claims 1-6, 11-23, and 26-36 recite allowable subject matter. It is therefore respectfully requested that all of claims 1-6, 11-23, and 26-36 be allowed, and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applicants' undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

  
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Enclosures: Additional Claim Fee Transmittal  
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